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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,206	01/18/2002	James C. Dow	10980473-8	4060

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P. O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

LEE, CHEUKFAN

ART UNIT PAPER NUMBER

2622

DATE MAILED: 10/07/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/053,206	DOW ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Cheukfan Lee	2622

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 January 2002.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-28 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

Art Unit: 2622

1. Claims 1-28 are pending. Claims 1, 6, 14, 19, 23, 27, and 28 are independent.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,301,020. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

Claim 1 claims all limitations of patent claim 1, except that claim recites "a digital camera" in place of the "a hand-held image capture and communication appliance" of patent claim 1.

A comparison between the two terms shows that they both are hand-held devices since a digital camera is hand-held when in use, and both are for capturing an image. According to the body of claim 1, one of ordinary skill in the art would have realized that the image data in the appliance is converted to digital format within the appliance.

Though the digital camera of claim 1 is not a "communication" device as the "hand-held image capture and communication appliance" is a communication device, In Re Karlson states that "omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same function as before". In the present case, one of ordinary skill in the art would have realized that without "communication", the rest of the claimed elements function the same. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to omit the "communication" function of the device of patent claim 1 to have a simpler device.

Further, because of the similarity of the hand-held appliance and the digital camera stated above, one of ordinary skill in the art would have recognized the advantage of replacing the hand-held appliance with a digital camera since in general digital cameras are relatively easy to handle when in use for taking pictures. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the components in the body of patent claim 1 in a digital camera for easy handling when taking a picture.

Claims 2, 3, 4, 6, 7, 8, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 23, 24, 25, 27, and 28 claim the limitations of patent claims 2-24, except that the claims claim "a digital camera" in place of "a hand-held image capturing and communication appliance" of the patent claims. Please see reasons of obviousness given for claim 1 above.

Claim 5 recites the limitations of claim 1, except that claim 5 claims "a digital camera" in place of "a hand-held image capturing and communication appliance".

Please refer to the discussions for claim 1 other than the discussion with respect to In Re Karlson, since claim 5 recites "means for communicating image data with a remote device".

Because the patent claim 1 appliance is an "image capture communication appliance", one of ordinary skill in the art would have realized that the appliance has the capability and function to communicate image data with a remote device. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the digital camera with means for communicating the image data to a remote device for viewing, storing or processing at the remote device.

Claims 9, 22 and 26 correspond to patent claims 6, 19 and 23, as claim 5 corresponds to claim 1, and are rejected for the same reasons of obviousness given for claim 5.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dow et al. (U.S. Patent No. 6,496,284) discloses an appliance and method of using the same having a delete capability for saved data.

Dow et al. (U.S. Patent No. 6,292,273) discloses an appliance and method of using the same having a delete capability for saved data.

Dow et al. (U.S. Patent No. 6,469,689) discloses an appliance and method of using the same having a capability to graphically associate and disassociate data with and from one another.

Dow et al. (U.S. Patent No. 6,466,231) discloses an appliance and method of using the same for capturing images.

Dow et al. (U.S. Patent No. 6,549,304) discloses a scanning appliance and method having user help capability.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee whose telephone number is (703) 305-4867. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cheukfan Lee  
September 21, 2004

